

REMARKS

Introduction

Claims 1, 2, 6, 11, and 13 remain pending in the present application. In this Response, claim 1 has been amended and claims 3-5, 7-10, and 12 have been cancelled. Applicants would like to thank the Examiner for indicating dependent claims 2 and 11 as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections at least in view of the foregoing amendments and the following remarks.

Rejection under 35 U.S.C. § 103

Claims 1, 3, 6, 12, and 13 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Publication No. 2002/0025402 (hereinafter “Tronche”) in view of JP 2002-309119 (hereinafter “Oishi”). This rejection is respectfully traversed.

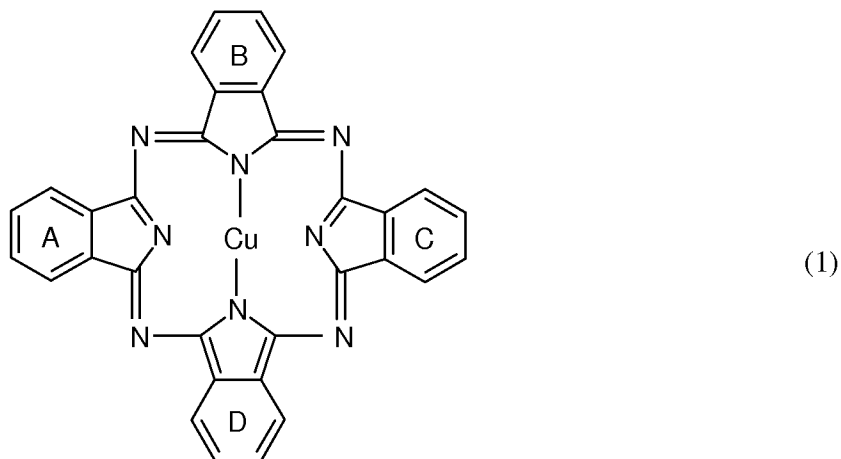
Legal Standard

It should be noted that the Office has the initial burden of establishing a factual basis to support the legal conclusion of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). For rejections under 35 U.S.C. § 103(a) based upon a combination of prior art elements, in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), the Supreme Court stated that a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Pending Claims

Amended independent claim 1, from which rejected dependent claims 2, 6, 11, and 13 directly or indirectly depend, recites a photosensitive resin composition comprising

as a component (A) a halogen-free green colorant of the formula



in which the rings A, B, C and D are substituted by the moiety $-\text{O}-(\text{CR}_1\text{R}_2)_n-$ ,

wherein R_1 is hydrogen or $\text{C}_1\text{-C}_4\text{-Alkyl}$, R_2 is hydrogen or $\text{C}_1\text{-C}_4\text{-Alkyl}$,

n is 0, 1, 2 or 3 and the ring E is unsubstituted or substituted by $\text{C}_1\text{-C}_6\text{alkyl}$, $\text{C}_1\text{-C}_6\text{alkoxy}$, hydroxy, NHCOR_3 , NHSO_2R_4 or SO_2NHR_5 , wherein R_3 is $\text{C}_1\text{-C}_4\text{-Alkyl}$ or phenyl, R_4 is $\text{C}_1\text{-C}_4\text{-Alkyl}$ or phenyl and R_5 is $\text{C}_1\text{-C}_4\text{-Alkyl}$ or phenyl,

b) as a component (B) an alkali soluble reactive or unreactive oligomer or reactive or unreactive polymer,

c) as a component (C) a polymerizable monomer,

d) as a component (D) a photoinitiator,

e) as a component (E) an epoxy compound,

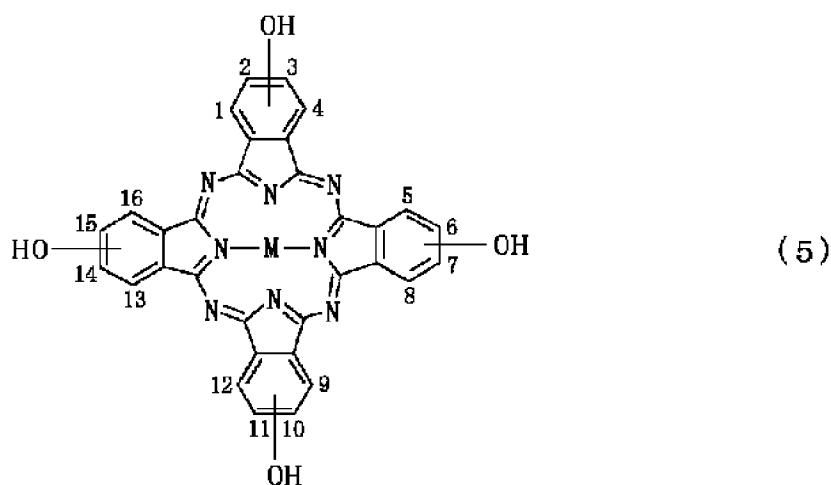
and also, if desired,

f) as a component (F) further additives.

Cited Art

Tronche is directed to a radiation-curable coating composition comprising at least one acrylate monomer and a phthalocyanine dye. (Abstract and Page 5, paragraph [0046]).

Oishi is directed to a phthalocyanine compound having the following formula:

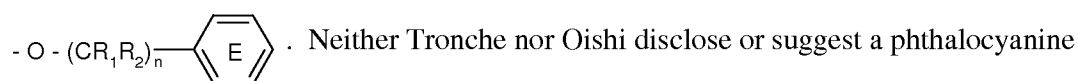


Differences between Pending Claims and Cited Art

With regard to Tronche, it is respectfully submitted that Tronche at least fails to disclose or suggest the presently recited compound of formula (1).

The Examiner concedes that Tronche does not disclose or suggest the presently recited compound of formula (1) and thus cites Oishi to allegedly cure this deficiency. (Page 3, Office Action dated December 9, 2010).

With regard to Oishi, it is respectfully submitted that even Oishi fails to teach the presently recited phthalocyanine compound which does not have any hydroxy substituents as are required in Oishi's compound (5). In fact, the presently recited compound of formula (1) (shown hereinabove) requires that A, B, C, and D are substituted by the moiety



compound having the foregoing moieties.

Thus, Tronche and Oishi, either alone or in combination, fail to disclose or suggest the presently recited compounds.

Even if it were assumed *arguendo* that a *prima facie* case of obviousness has been established in view of the cited art, a *prima facie* case of obviousness can be rebutted by a showing of unexpected results. (See, for example, *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)). In this regard, as discussed in the previous response, it should be noted that the examples in the present specification show that no discoloration of the cured coating occurred after heat treatment compared to the reference. (See Examples in the present specification). Thus, the use of the presently recited compounds shows good heat stability.

The cited art also does not appreciate the importance and resulting advantages of the presently recited compound of formula (1), which is a halogen-free green colorant and can be used in solder resists, etching resists or plating resists in the manufacture of printed circuit boards. (See, for example, page 1 of the present specification). Thus, it is respectfully submitted that Tronche and Oishi fail to disclose or suggest the presently recited compound.

In view of at least the above, the rejection over Tronche and Oishi should be withdrawn.

Conclusion

The Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below if any issues remain in this matter, or if a discussion regarding any portion of the application is desired by the Examiner.

Respectfully submitted,
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